



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,232	02/22/2005	Werner Gauweiler	266122US0PCT	7199
22850 7590 02/05/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER ROGERS, JAMES WILLIAM	
			ART UNIT	PAPER NUMBER
			1618	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/05/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/525,232	<b>Applicant(s)</b> GAUWEILER ET AL.	
	<b>Examiner</b> James W. Rogers, Ph.D.	<b>Art Unit</b> 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6 and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 05/16/2005
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group 1 claims 1-3 and 6-7 in the reply filed on 12/13/2006 is acknowledged. The traversal is on the ground(s) that the examiner has not provided the burden of explaining why there is no single inventive concept. Applicant also states that the polymers of the instant invention are different because they are synthesized by W/W emulsion. Applicant lastly asserts that the claims in each group are considered related inventions and that a search of all claims would not be burdensome. This is not found persuasive because as previously disclosed in the office action mailed 11/13/2006, the inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1. This is 1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Each cationic or cationogenic vinyl group-containing monomers from Groups I-III are not all encompassed within crosslinked cationic polymers used in cosmetic compositions. This is evidenced by WO 96/37525 (cited by applicants), which describes crosslinked hydrogels of quarternized vinylimidazoles and their use in detergents. 525' does not disclose the use of the monomers in groups II-III thus unity of invention for groups I-III is lacking. Thus the burden of explaining why there is no single inventive concept under PCT Rule 13.1 is considered met by the examiner. The instant claims, even though they are in improper "use" format (see below) seem to be directed to a polymer therefore applicants assertion that the polymers are made by W/W emulsion and are therefore different bears no weight because the patentability of a product does

Art Unit: 1618

not depend on its method of production. Lastly as evidenced above the claims in each group while being related as a genus of cationic polymers it is obvious from the above that the groups all claim very different monomers from one another, therefore the polymers will be quite different and require a separate search for each polymer, putting an undue burden on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 and 6-7 provides for the use of a crosslinked cationic polymer, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically in claim 1 part F) the recitation of 1 to 100% by weight of the saturation amount in the reaction medium of one or more organic or inorganic salts, the phrase "saturation amount" is a relative term, which renders the claim indefinite. The phrase "saturation amount" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite concentration, and one of ordinary skill in the art would not be reasonably apprised of the scope of the

Art Unit: 1618

invention. The limitation "saturation amount" is indefinite because it is in open ended phrase. Also in claim 1 part g) recites "protective colloid", this phrase is also considered to be indefinite, for instance what is the colloid protecting?. It is suggested by the examiner to delete the word "protective" in part g) of claim 1. It is also unclear as presently written in claim 1 whether or not parts f) and G) would be incorporated within the cationic crosslinked polymer when the polymer is prepared, from the specification it appears that parts F) and G) are only used to stabilize the polymer, but it appears the entire solution in the experimental (including the salt and colloid) was used in the cosmetic preparations. The examiner will examine the limitations of parts F) and G) as stabilizing components which are not in any way coordinated or bonded to the cationic polymer but further clarification and support is required to overcome this rejection.

***Claim Rejections - 35 USC § 101***

Claims 1-3 and 6-7 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966). In order to expedite the examining process the examiner will interpret claim 1 to be a product claim for a cationic crosslinked polymer and the "The use of" preamble at the beginning of claim 1 will be treated as an intended use limitation and the examiner will search only for the cationic crosslinked polymer recited in claim 1. The examiner concludes that the claims appear to be directed towards a product as also evidenced by

Art Unit: 1618

applicants response to the election/restriction filed 12/13/2006 because of the recitation "claims 1-7 are directed to crosslinked cationic polymers" on page 3 lin 16, therefore this is considered by the examiner to be the proper interpretation of the claims. If the applicants disagree with the interpretation and the claims are instead directed for instance to a process of producing the polymer or directed to a cosmetic composition the examiner invites applicants to amend the claims so that they are not longer indefinite as to the invention claimed in accordance with the MPEP.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Schade et al. (US 5,962,613).

Schade discloses water soluble crosslinked copolymers comprising a) 10-89.5% by weight monomers of vinyl imidazoles of formula (I) and monomers of formula (II) including N-vinylcaprolactam and mixtures of said monomers B) 0-89.5% by weight of other copolymerizable monoethylenically unsaturated monomers, including charged quarternized monomers such as vinylimidazole and C) 0.5-30% by weight of at least one monomer which acts as a crosslinker and has at least two non-conjugated ethylenic double bonds, the polymers were recited as being useful in cosmetics. See col 2 lin 22- col 4 lin 65, col 9 lin 13-14 and claims 1-3. Regarding the limitation that the

Art Unit: 1618

polymerization of the polymer occurs in the presence of f) an organic or inorganic salt and g) a protective colloid this appears to be a product by process type of limitation and therefore received no patentable weight because as described above the examiner is examining the claims as a product (polymer). "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Regarding claims 2 and 7 which are intended use type of claims, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Since applicants crosslinked polymer is met by the Schade patent it is capable of performing the same intended use therefore the intended use limitations are met.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

Art Unit: 1618

F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 and 6-7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 of copending Application No. 09/604,001. Although the conflicting claims are not identical, they are not patentably distinct from each other because the crosslinked cationic polymer formed by monomers selected from N-vinylimidazole, N-vinyl lactam and a monomer which acts as a crosslinker are the same and therefore the polymer prepared from the monomers would be the same.

Claims 1-3 and 6-7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3,7,9,12-15 and 20-21 of copending Application No. 10/524,370. Although the conflicting claims are not identical, they are not patentably distinct from each other because the crosslinked cationic polymer formed by monomers selected from N-vinylimidazole, N-vinyl lactam and a monomer which acts as a crosslinker are the same and therefore the polymers prepared from the monomers would be the same.



Art Unit: 1618

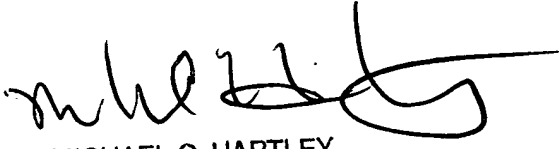
This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### **Conclusion**

No claims are allowed. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers, Ph.D. whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MICHAEL G. HARTLEY  
SUPERVISORY PATENT EXAMINER